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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,988	12/14/2001	William R. Matz	36968/265390 (BS01371)	4972
23552	7590	07/26/2006	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			KOENIG, ANDREW Y	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/016,988	Applicant(s) MATZ ET AL.	
	Examiner Andrew Y. Koenig	Art Unit 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>See cont. sheet.</u> | 6) <input type="checkbox"/> Other: ____.  |

3. Information Disclosure Statements: 3/11/02, 1/29/04, 1/28/05, 7/25/05, 10/26/05, 11/15/05,  
12/6/05, 5/18/06

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 6, 7, 11, 12, 15, 16, 20, 21, 25, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,029,045 to Picco et al. (Picco).

Regarding claim 1, Picco teaches a system and method for marketing targeted advertisements, wherein the system defines a match between a user classification and an advertisements (col. 7, ll. 12-32), an agent (fig. 4, label 150) and statistical collector (fig. 4, label 152) receiving user data associated with a user terminal from subscribers (col. 7, ll. 12-32, see also, col. 7-8, ll. 33-6), wherein the agent classifies the user in a user classification (based on received data) (col. 7-8, ll. 33-6), a broadcasting station (fig. 1, label 102) for transmitting the media content to users (col. 8, ll. 23-55), wherein the media content comprises video (col. 12, ll. 24-36), and the set top box inserts the local content, if a match is defined between the user classification and the advertisements (col. 12, ll. 24-36).

Regarding claims 2 and 16, Picco teaches user data comprising user viewing selections (col. 7, ll. 12-14).

Regarding claims 6 and 20, Picco teaches classifying the user if the user data satisfies a predefined parameter (col. 7-8, ll. 61-6).

Regarding claims 7 and 21, Picco teaches inserting the advertisements (col. 13-14, ll. 67-13), which reads on embedding the advertisements into the media content.

Regarding claims 11 and 25, Picco teaches video advertisements within content, which reads on an image embedded into media content.

Regarding claims 12 and 26, Picco teaches video advertisements within content, which reads on a video program.

Regarding claim 15, Picco teaches a system and method for marketing targeted advertisements, wherein the system defines a match between a user classification and an advertisements (col. 7, ll. 12-32), an agent (fig. 4, label 150) and statistical collector (fig. 4, label 152) receiving user data associated with a user terminal from subscribers (col. 7, ll. 12-32, see also, col. 7-8, ll. 33-6), wherein the agent classifies the user in a user classification (based on received data) (col. 7-8, ll. 33-6), a broadcasting station (fig. 1, label 102) for transmitting the media content to users (col. 8, ll. 23-55), wherein the media content comprises video (col. 12, ll. 24-36), and the transmitter transmits inserts the local content in the broadcast stream, if a match is defined between the user classification and the advertisements (col. 12, ll. 24-36), which reads on inserting the local content in the media content, if a match is defined between the user classification and the advertisements.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 8, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,029,045 to Picco et al. (Picco) in view of U.S. Patent 5,945,988 to Williams et al. (Williams).

Regarding claims 3 and 17, Picco teaches household data, but is silent on receiving user identification associated with the user, wherein a plurality of users are associated with a user terminal. In analogous art, Williams teaches configuring a system in accordance for at one of plurality of users associated with a terminal (fig. 3, col. 8-9, ll. 56-30), wherein the system receives an identification associated with the user (col9-10, ll. 64-12, col. 10, ll. 37-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco by receiving user identification associated with the user, wherein a plurality of users are associated with a user terminal as taught by Williams in order to identify which user is using the system and personalize the information directed specifically to the user, thereby creating a better experience for the user of the system.

Regarding claims 8 and 22, Picco is silent on user data comprising global computer network viewing data. In analogous art, Williams teaches user data such as time logged on a particular web page (col. 7, ll. 57-62), which reads on global computer network viewing data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco by using user data comprising global computer network viewing data as taught by Williams in order to

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update and refine the user profile information, thereby enabling the system to reflect changes in behavior and use.

5. Claims 4, 5, 9, 10, 18 19, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,029,045 to Picco et al. (Picco) in view of U.S. Patent Application Publication 2002/0056109 to Tomsen.

Regarding claims 4 and 18, Picco is silent on a relationship between sales data and user viewing selections, and classifying the user in a classification if the relationship is detected. Tomsen teaches a relationship between sales data and user viewing selections, and classifying the user in a classification if the relationship is detected (pg. 5, para. 0052-0053). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco by a relationship between sales data and user viewing selections, and classifying the user in a classification if the relationship is detected as taught by Tomsen in order to provide information that would be desirable to the user, such as golf equipment.

Regarding claims 5 and 19, Picco is silent on detecting a relation if the user views an advertisement for a product and purchases the product. Tomsen teaches detecting a relation from an advertisement for a product and the purchasing of the product (pg. 5, para. 0046). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco by detecting a relation if the user views an advertisement for a product and purchases the product as taught by

Tomsen in order to effectively maintain a profile of the user to better provide desirable information to the user.

Regarding claims 9 and 23, Picco is silent on survey data. Tomsen teaches survey data (pg. 6, para 0060). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco by using survey data as taught by Tomsen in order to collect information, thereby enabling marketers to better target an individual. .

Regarding claims 10 and 24, Picco is silent on sales data. Tomsen teaches monitoring purchases items from a web site of the merchant (pg. 6, para. 0053), which reads on sales data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco by using sales data as taught by Tomsen in order to receive explicit information on products which the user buys, thereby enabling marketers to better target an individual.

6. Claims 13 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,029,045 to Picco et al. (Picco).

Regarding claims 13 and 27, Picco is silent on the advertisement comprising a banner. Official Notice is taken that the use of using a banner for an advertisement is known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco by using a banner for an advertisement in order to provide targeted content while the user is viewing a program.



7. Claims 14 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,029,045 to Picco et al. (Picco) in view of U.S. Patent 6,177,931 to Alexander et al. (Alexander).

Regarding claims 14 and 28, Picco is silent on the advertisement appearing at the same time as an electronic program guide (EPG). In analogous art, Alexander teaches placing advertisements appearing at the same time as an electronic program guide (EPG) (see. Fig. 1, 3, 4A, 4B, 5-9, 10A, and 10B). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Picco by placing advertisements appearing at the same time as an electronic program guide as taught by Alexander in order to improve opportunities for commercial advertisers to reach the viewer and enable product information access by the viewer (Alexander: col. 2, ll. 13-21).

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (571) 272-7296. The examiner can normally be reached on M-Fr (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571)272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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